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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,753	01/30/2002	Toshifumi Komatsu	2970.98US01	6971
7590 04/01/2005				
Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0903				
			EXAMINER	
			GILLIAM, BARBARA LEE	
			ART UNIT	PAPER NUMBER
			1752	
DATE MAILED: 04/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/060,753	Applicant(s) KOMATSU ET AL.	
	Examiner Barbara L. Gilliam	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,9,12-17,19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,9,12-17,19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. The amendment filed December 20, 2004 has been entered and fully considered.
The amendment to claim 1 is fully supported by original claim 20.
2. Claims 1-3, 5-6, 9, 12-17, 19, 21-25 are present.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. Claims 13-14 are redundant in requiring the ink receptive, radiation transmissive layer to contain calcium carbonate.
 - b. Because the photoresist layer comprises a pressure sensitive adhesive composition, it is implied that the adhesive of Claim 15 is present.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5-6, 9, 12-17, 19, 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoogmartens et al. (US 5,922,506) in view of Asano et al. (US 6,106,992).

a. In US 5,922,506, Hoogmartens et al. teach a negative-working photosensitive imaging element comprising on a hydrophilic surface of a support in the order given, a hydrophobic photopolymerization layer contiguous to the hydrophilic surface of the support and comprising at least part of at least one unsaturated compound, a hydrophobic photosensitive layer contiguous to the polymerizable layer and comprising at least part of at least one hydrophobic thermoplastic polymer and at least one photoinitiator and optionally a receptor layer (claim 1). The thermoplastic polymers are used in an amount of at least 50% by weight and examples thereof include polyvinyl acetate (column 6, lines 50-51; column 8, lines 47-54). Agents to improve the wetting an/or adjust the adhesion of the photopolymerizable composition may be added (column 7, lines 37-43 & column 8, lines 42-46). The support can comprise a polyethylene layer (column 10, lines 44-54) and comprise one or more hydrophilic layers such as layers of hardened polyvinyl alcohol (column 10, lines 25-36). The support meets the present limitations for the carrier layer and the hydrophilic layer coated thereon meets the present limitations for the membrane layer. The imaging element of Hoogmartens et al. may comprise a temporary protective layer on top of the photosensitive layer, which can comprise polyvinyl alcohol. The temporary layer can be

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removed before or after the photoexposure step (column 10, lines 62-67). Preferably the imaging element either comprises a receptor layer or a transfer layer and a receptor layer wherein the transfer layer is between the photosensitive composition and the receptor layer. Suitable receptor layers include transparent organic resins (column 11, lines 1-25). The temporary protective layer and the receptor layer meet the present limitations for the ink-receptive, radiation transmissive layer. Additionally the temporary protective layer meets the present limitations for the printable cover sheet. Hoogmartens et al. do not teach organic or inorganic particles in the temporary protective layer or the receptor layer however, based on the teachings of Asano et al. (column 14, lines 55-67 & column 21, lines 33-46) it would have been obvious to incorporate fillers such as calcium carbonate into either layer to reduce to cost and increase handleability. The imaging element is then image-wise exposed to actinic radiation (column 13, line 46 – column 14, line 58).

Response to Arguments

7. Applicant's statement filed December 20, 2004 has been fully considered but they is not persuasive. Applicant argued that one of ordinary skill would not combine the teachings of Asano with Hoogmartens because Asano is directed to a positive working film and Hoogmartens is directed to a negative working film. Applicant further argues there is no teaching for an ink receptive layer in Asano and that calcium carbonate is only incorporated into the interior layers and not present in a layer near the exterior surface of the multilayer film. The Examiner relied upon the teachings of Asano for the sole purpose to show it would be obvious to incorporate a filler, such as calcium

carbonate, into the temporary protective layer. According to Asano, it would have been obvious to incorporate such fillers in a photosensitive resin composition to reduce cost and to improve handleability (column 14, lines 55-67 & column 21, lines 33-46). It is the Examiner's position that it would have been obvious to incorporate the filler in the receptor layer or the temporary cover sheet for the same reasons. The Examiner maintains the claims are obvious in view of Hoogmartens et al. (US 5,922,506) as modified by Asano et al. (US 6,106,992).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

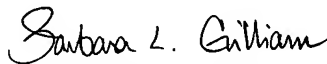
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-

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1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
March 30, 2005